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Filed 18 January 2006

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES  
(Senior Administrative Patent Judge McKelvey)

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ROBERT H. GRUBBS, DONALD W. WARD,  
THOMAS J. SEIDERS and STEVEN D. GOLDBERG,

Junior Party  
(Application 10/124,745),

v.

STEVEN P. NOLAN and JINKUN HUANG,

Senior Party  
(Application 09/392,869).

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Patent Interference No. 105,374  
Technology Center 1600

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**REDECLARATION - Bd.R. 203(c)**

**A. Introduction**

1. In the ORDER SETTING TIMES FOR TAKING ACTION--  
MOTIONS PHASE (Paper 27, Part B(5)), it was indicated that a  
formal order redeclaring the interference would be entered during  
the first week in January of 2006.

2. This REDECLARATION is intended to be that formal  
order.

1           **B.     Order**

2           Substitution of Counts 4, 5 and 6 for Counts 1, 2 and 3

3           1.     The parties have agreed that Count 4 should be  
4 substituted for Count 1 (Paper 1, pages 6-7); the board concurs  
5 (Paper 27, page 2, ¶ B(1)).

6           2.     The parties have agreed that Count 5 should be  
7 substituted for Count 2 (Paper 1, pages 8-9); the board concurs  
8 (Paper 27, page 2, ¶ B(1)).

9           3.     The parties have agreed that Count 6 should be  
10 substituted for Count 3 (Paper 1, pages 10-11); the board concurs  
11 (Paper 27, page 2, ¶ B(1)).

12          4.     Count 4, which is set out in Appendix 1 of this  
13 REDECLARATION is substituted for Count 1 (Paper 1, pages 6-7).

14          5.     Count 5, which is set out in Appendix 2 of this  
15 REDECLARATION is substituted for Count 2 (Paper 1, pages 8-9).

16          6.     Count 6, which is set out in Appendix 3 of this  
17 REDECLARATION is substituted for Count 2 (Paper 1, pages 10-11).

18                           Claim correspondence  
19

20          7.     In a MEMORANDUM OPINION and ORDER -- Bd.R. 104(a)  
21 (Paper 3), the board (1) invited Nolan to correct Fig. 4 of its  
22 drawings and (2) required the parties to submit a new set of  
23 claims.

24          8.     Because the parties have agreed on a count which  
25 the board finds suitable, there is no need for the parties to  
26 file an amendment (Paper 29, pages 2-3, ¶¶ 6-9).

1           9.   Accordingly, any amendments of the claims  
2 submitted by the parties need not be entered.

3           10.   Instead, the interference can be resolved on the  
4 basis of the Grubbs and Nolan claims presently in the respective  
5 applications involved in the interference.

6  
7           11.   The claims of the parties are:

8                   Grubbs:   1-34 and 40-75

9  
10                   Nolan:    9, 11-14, 17-21, 23-40, 43-65, 71-73 and  
11                               77-111

12  
13           12.   The claims of the parties which correspond to  
14 Count 4 are:

15                   Grubbs:   1-15, 17-34 and 40-75

16                   Nolan:    9, 11-14, 17-21, 23-40, 45-46, 51-63,  
17                               65, and 77-78, 89-92 and 107-109

18  
19           13.   The claims of the parties which do not correspond  
20 to Count 4 are:

21                   Grubbs:   16

22                   Nolan:    43-44, 47-50, 64, 71-73, 79-88, 93-106  
23                               and 110-111

24  
25           14.   The claims of the parties which correspond to  
26 Count 5 are:

27                   Grubbs:   1-9, 11-15, 17-34, 40-48 and 64-74

28                   Nolan:    14, 17-21, 23-26, 33-38, 43-44, 47-48,  
29                               53-58, 60-62, 77-78 and 90-111

1           15. The claims of the parties which do not correspond  
2 to Count 5 are:

3                   Grubbs: 10, 16, 49-63 and 75

4                   Nolan: 9, 11-13, 27-32, 39-40, 45-46, 49-52,  
5                           59, 63-65, 71-73 and 79-89  
6  
7

8           16. The claims of the parties which correspond to  
9 Count 6 are:

10                   Grubbs: 1-9, 11-15, 17-34, 40-48 and 64-74

11                   Nolan: 9, 11-14, 17-21, 23-38, 43-44, 49-62,  
12                           77-78, 90-92 and 107-109  
13

14           17. The claims of the parties which do not correspond  
15 to Count 6 are:

16                   Grubbs: 10, 16, 49-63 and 75

17                   Nolan: 39-40, 45-48, 63-65, 71-73, 79-89, 93-  
18                           106 and 110-111  
19  
20

21                           Priority benefit

22           18. Consistent with discussion during a conference  
23 call (Paper 27, page 2, ¶ B(4)), the benefit accorded in the  
24 DECLARATION (Paper 1, pages 3 and 4) would be accorded.

25           19. Since no benefit was accorded in the DECLARATION,  
26 no benefit is accorded to either party with respect to any of  
27 Counts 4, 5 or 6.  
28

29                           Nolan request to amend its drawing

30           20. Nolan has filed an amendment to correct Fig. 4 of  
31 its drawings.

1                   21. Entry of the amendment is being authorized in  
2     Grubbs v. Nolan, Interference 105,373.

3  
4  
5  
6                                   /s/Fred E. McKelvey  
7                                   FRED E. McKELVEY,  
8                                   Senior Administrative Patent Judge<sup>1</sup>  
9

10  
11     18 January 2006  
12     Alexandria, VA

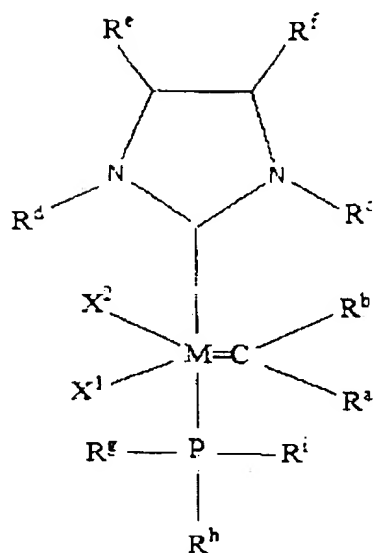
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<sup>1</sup> As part of board efforts under the government Paperwork Elimination Act, signatures on papers originating from the board have been phased out in favor of a completely electronic record. Consequently, in this case papers originating at the board will not have signatures. The signature requirements for the parties have not changed. See, e.g., 37 CFR § 10.18.

# Appendix 1

## Count 4

A composition of matter have the formula:



where:

M is Ru or Os;

X<sup>1</sup> and X<sup>2</sup> are each independently an anionic ligand;

P is phosphorus

R<sup>a</sup> is:

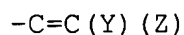
- (1) hydrogen,
- (2) a hydrocarbyl group or
- (3) a hydrocarbyl group substituted with a
  - (a) a C<sub>1-10</sub> alkyl group,
  - (b) a C<sub>1-10</sub> alkoxy group,

- 1 (c) halogen or  
2  
3 (d) a phenyl group substituted with:  
4  
5 (i) halogen,  
6  
7 (ii) a C<sub>1-5</sub> alkyl group or  
8  
9 (iii) a C<sub>1-5</sub> alkoxy group, and  
10  
11

12 R<sup>b</sup> is:

- 13 (1) hydrogen,  
14  
15 (2) a carboxy group  
16  
17 (3) a hydrocarbyl group or  
18  
19 (4) a hydrocarbyl group substituted with a  
20  
21 (a) a C<sub>1-10</sub> alkyl group,  
22  
23 (b) a C<sub>1-10</sub> alkoxy group,  
24  
25 (c) halogen or  
26  
27 (d) a phenyl group substituted with:  
28  
29 (i) halogen,  
30  
31 (ii) a C<sub>1-5</sub> alkyl group or  
32  
33 (iii) a C<sub>1-5</sub> alkoxy group,  
34  
35

36 with the proviso that neither R<sup>a</sup> or R<sup>b</sup> can be



38 where Y and Z are each independently any moiety;  
39

40 R<sup>c</sup> and R<sup>d</sup> are each independently:  
41

- 42 (1) hydrogen,  
43  
44 (2) a C<sub>2-20</sub> alkoxy carbonyl group,  
45  
46 (3) a C<sub>1-20</sub> carboxylato group,  
47  
48 (4) a C<sub>1-20</sub> alkoxy group,  
49  
50 (5) a C<sub>2-20</sub> alkenyloxy group,  
51  
52

- 1 (6) a C<sub>2-20</sub> alkynyloxy group,  
2  
3 (7) an aryloxy group,  
4  
5 (8) a hydrocarbyl group or  
6  
7 (9) a hydrocarbyl group substituted with  
8  
9 (a) a C<sub>1-10</sub> alkyl group,  
10  
11 (b) a C<sub>1-10</sub> alkoxy group,  
12  
13 (c) halogen or  
14  
15 (d) a phenyl group substituted with  
16  
17 (i) halogen  
18  
19 (ii) a C<sub>1-5</sub> alkyl group or  
20  
21 (iii) a C<sub>1-5</sub> alkoxy group; and  
22

23 R<sup>e</sup> and R<sup>f</sup> are each independently;  
24

- 25 (1) hydrogen,  
26  
27 (2) a hydrocarbyl group,  
28  
29 (3) a C<sub>2-20</sub> alkoxy carbonyl group,  
30  
31 (4) a C<sub>1-20</sub> carboxylato group,  
32  
33 (5) a C<sub>1-20</sub> alkoxy group,  
34  
35 (6) a C<sub>2-20</sub> alkenyloxy group,  
36  
37 (7) a C<sub>2-20</sub> alkynyloxy group,  
38  
39 (8) an aryloxy group,  
40

41 where each R<sup>e</sup> and R<sup>f</sup> is optionally substituted with:  
42

- 43 (a) a C<sub>1-5</sub> alkyl group,  
44  
45 (b) a C<sub>1-5</sub> alkoxy group,  
46  
47 (c) halogen or  
48  
49 (d) a phenyl group substituted with:  
50  
51  
52



1 (i) halogen,

2 (ii) a C<sub>1-5</sub> alkyl group or

3 (iii) a C<sub>1-5</sub> alkoxy group;

4  
5 R<sup>g</sup>, R<sup>h</sup> and R<sup>i</sup> are each independently:

6 (1) a C<sub>1-10</sub> alkyl group,

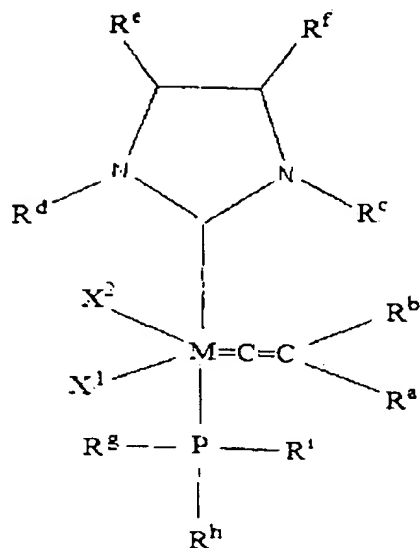
7 (2) a C<sub>3-10</sub> cycloalkyl group or

8 (3) a C<sub>5-20</sub> aryl group.

## Appendix 2

### Count 5

A composition of matter having the formula:



where:

M is Ru or Os;

X<sup>1</sup> and X<sup>2</sup> are each independently an anionic ligand;

P is phosphorus

R<sup>a</sup> is:

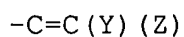
- (1) hydrogen,
- (2) a hydrocarbyl group or
- (3) a hydrocarbyl group substituted with a
  - (a) a C<sub>1-10</sub> alkyl group,
  - (b) a C<sub>1-10</sub> alkoxy group,
  - (c) halogen or
  - (d) a phenyl group substituted with:

- 1 (i) halogen,  
2  
3 (ii) a C<sub>1-5</sub> alkyl group or  
4  
5 (iii) a C<sub>1-5</sub> alkoxy group, and  
6

7 R<sup>b</sup> is:

- 8  
9 (1) hydrogen,  
10  
11 (2) a carboxy group  
12  
13 (3) a hydrocarbyl group or  
14  
15 (4) a hydrocarbyl group substituted with a  
16  
17 (a) a C<sub>1-10</sub> alkyl group,  
18  
19 (b) a C<sub>1-10</sub> alkoxy group,  
20  
21 (c) halogen or  
22  
23 (d) a phenyl group substituted with:  
24  
25 (i) halogen,  
26  
27 (ii) a C<sub>1-5</sub> alkyl group or  
28  
29 (iii) a C<sub>1-5</sub> alkoxy group,  
30

31 with the proviso that neither R<sup>a</sup> or R<sup>b</sup> can be



35 where Y and Z are each independently any moiety;

36  
37 R<sup>c</sup> and R<sup>d</sup> are each independently:

- 38  
39 (1) hydrogen,  
40  
41 (2) a C<sub>2-20</sub> alkoxy carbonyl group,  
42  
43 (3) a C<sub>1-20</sub> carboxylato group,  
44  
45 (4) a C<sub>1-20</sub> alkoxy group,  
46  
47 (5) a C<sub>2-20</sub> alkenyloxy group,  
48  
49 (6) a C<sub>2-20</sub> alkynyloxy group,  
50  
51 (7) an aryloxy group,  
52

- 1 (8) a hydrocarbyl group or  
2  
3 (9) a hydrocarbyl group substituted with  
4  
5 (a) a C<sub>1-10</sub> alkyl group,  
6  
7 (b) a C<sub>1-10</sub> alkoxy group,  
8  
9 (c) halogen or  
10  
11 (d) a phenyl group substituted with  
12  
13 (i) halogen  
14  
15 (ii) a C<sub>1-5</sub> alkyl group or  
16  
17 (iii) a C<sub>1-5</sub> alkoxy group; and  
18

19 R<sup>e</sup> and R<sup>f</sup> are each independently;  
20

- 21 (1) hydrogen,  
22  
23 (2) a hydrocarbyl group,  
24  
25 (3) a C<sub>2-20</sub> alkoxy carbonyl group,  
26  
27 (4) a C<sub>1-20</sub> carboxylato group,  
28  
29 (5) a C<sub>1-20</sub> alkoxy group,  
30  
31 (6) a C<sub>2-20</sub> alkenyloxy group,  
32  
33 (7) a C<sub>2-20</sub> alkynyloxy group,  
34  
35 (8) an aryloxy group,  
36

37 where each R<sup>e</sup> and R<sup>f</sup> is optionally substituted with:  
38

- 39 (a) a C<sub>1-5</sub> alkyl group,  
40  
41 (b) a C<sub>1-5</sub> alkoxy group,  
42  
43 (c) halogen or  
44  
45 (d) a phenyl group substituted with:  
46  
47 (i) halogen,  
48  
49 (ii) a C<sub>1-5</sub> alkyl group or  
50  
51 (iii) a C<sub>1-5</sub> alkoxy group;  
52

1         $R^g$ ,  $R^h$  and  $R^i$  are each independently:  
2

3            (1) a  $C_{1-10}$  alkyl group,  
4

5            (2) a  $C_{3-10}$  cycloalkyl group or  
6

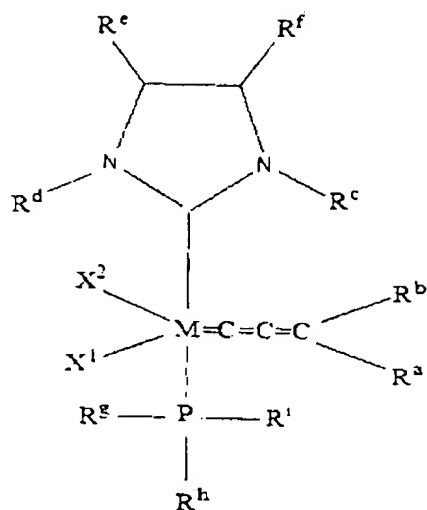
7            (3) a  $C_{5-20}$  aryl group.  
8  
9

10  
11  
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# Appendix 3

## Count 6

A composition of matter having the formula:



where:

M is Ru or Os;

X<sup>1</sup> and X<sup>2</sup> are each independently an anionic ligand;

P is phosphorus

R<sup>a</sup> is:

- (1) hydrogen,
- (2) a hydrocarbyl group or
- (3) a hydrocarbyl group substituted with a
  - (a) a C<sub>1-10</sub> alkyl group,
  - (b) a C<sub>1-10</sub> alkoxy group,
  - (c) halogen or

1 (d) a phenyl group substituted with:

2  
3 (i) halogen,

4 (ii) a C<sub>1-5</sub> alkyl group or

5 (iii) a C<sub>1-5</sub> alkoxy group, and

6  
7  
8  
9 R<sup>b</sup> is:

10 (1) hydrogen,

11 (2) a carboxy group

12 (3) a hydrocarbyl group or

13 (4) a hydrocarbyl group substituted with a

14 (a) a C<sub>1-10</sub> alkyl group,

15 (b) a C<sub>1-10</sub> alkoxy group,

16 (c) halogen or

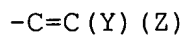
17 (d) a phenyl group substituted with:

18 (i) halogen,

19 (ii) a C<sub>1-5</sub> alkyl group or

20 (iii) a C<sub>1-5</sub> alkoxy group,

21 with the proviso that neither R<sup>a</sup> or R<sup>b</sup> can be



23 where Y and Z are each independently any moiety;

24 R<sup>c</sup> and R<sup>d</sup> are each independently:

25 (1) hydrogen,

26 (2) a C<sub>2-20</sub> alkoxy carbonyl group,

27 (3) a C<sub>1-20</sub> carboxylato group,

28 (4) a C<sub>1-20</sub> alkoxy group,

29 (5) a C<sub>2-20</sub> alkenyloxy group,

30 (6) a C<sub>2-20</sub> alkynyloxy group,

- 1 (7) an aryloxy group,  
2  
3 (8) a hydrocarbyl group or  
4  
5 (9) a hydrocarbyl group substituted with  
6  
7 (a) a C<sub>1-10</sub> alkyl group,  
8  
9 (b) a C<sub>1-10</sub> alkoxy group,  
10  
11 (c) halogen or  
12  
13 (d) a phenyl group substituted with  
14  
15 (i) halogen  
16  
17 (ii) a C<sub>1-5</sub> alkyl group or  
18  
19 (iii) a C<sub>1-5</sub> alkoxy group; and  
20  
21 R<sup>e</sup> and R<sup>f</sup> are each independently;  
22  
23 (1) hydrogen,  
24  
25 (2) a hydrocarbyl group,  
26  
27 (3) a C<sub>2-20</sub> alkoxy carbonyl group,  
28  
29 (4) a C<sub>1-20</sub> carboxylato group,  
30  
31 (5) a C<sub>1-20</sub> alkoxy group,  
32  
33 (6) a C<sub>2-20</sub> alkenyloxy group,  
34  
35 (7) a C<sub>2-20</sub> alkynyloxy group,  
36  
37 (8) an aryloxy group,  
38  
39 where each R<sup>e</sup> and R<sup>f</sup> is optionally substituted with:  
40  
41 (a) a C<sub>1-5</sub> alkyl group,  
42  
43 (b) a C<sub>1-5</sub> alkoxy group,  
44  
45 (c) halogen or  
46  
47 (d) a phenyl group substituted with:  
48  
49  
50  
51  
52



1 (i) halogen,

2 (ii) a C<sub>1-5</sub> alkyl group or

3 (iii) a C<sub>1-5</sub> alkoxy group;

4  
5 R<sup>g</sup>, R<sup>h</sup> and R<sup>i</sup> are each independently:

6 (1) a C<sub>1-10</sub> alkyl group,

7 (2) a C<sub>3-10</sub> cycloalkyl group or

8 (3) a C<sub>5-20</sub> aryl group.

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